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David Benjamin Auerbach

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GOOGLE / FENWICK
SILICON VALLEY CENTER
801 CALIFORNIA ST.
MOUNTAIN VIEW, CA 94041

EXAMINER

HICKS, MICHAEL J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/814,052	Applicant(s) AUERBACH ET AL.	
	Examiner Michael J. Hicks	Art Unit 2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8-25,47,49-51,54-61 and 73-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-25,47,49-51,54-61 and 73-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/8/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3-5, 8-25, 47, 49-51, 54-61, and 73-87 pending.
Claims 2, 6-7, 48, and 52-53 canceled.
Claims 26-46 and 62-72 withdrawn.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3-5, 8-25, 47, 49-51, 54-61, and 73-87 have been considered but are moot in view of the new ground(s) of rejection.

As per Applicants arguments that Mathur fails to disclose that the user action history includes actions performed on a plurality of articles, Examiner respectfully disagrees. Examiner asserts that although the example given indicates that the users is browsing only one web page, it is possible for a user to view multiple web pages simultaneously using one web browser. As such, the user action history may include actions performed on a plurality of documents, (e.g. the user accesses of multiple documents.)

As per Applicants arguments that Mathur fails to disclose the user action history includes timestamp information for the user actions, Examiner concedes that Mathur does not disclose this limitation. However, Examiner has identified the newly introduced reference of Brandli et al. (U.S. Patent Number 5701469 and referred to hereinafter as Brandli) which discloses timestamping in indexes used to create contextually accurate search

results. As such, the disclosure of Brandli will be added to the rejection to disclose the newly added limitations.

In light of the above arguments, the rejection has been updated to reflect the amendments made to the claims and maintained.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-5, 8, 11, 16-24, 47, 49-51, 54, 57, 73-77 and, 83-87 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view of Mathur and further in view of Brandli.

As per Claims 1 and 47, Tripp discloses a method comprising: generating a user context-dependent search query (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a*

user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that because the user input the query, the query is user context-dependant.) (Column 3, Lines 21-38); responsive to identifying an aspect associated with an article (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that before the search is performed, an aspect associated with an article (e.g. file) must be indicated. Note that an aspect may be any information associate with the file, and that the invention, as claimed, does not indicate any automation or computer involvement in identifying the aspect, thus a user searching for known files on the users computer meets the limitation.) (Column 3, Lines 21-38); generating an insert based, at least in part, on the aspect, wherein the insert comprises a search result (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that searching is provided, e.g. an insert in the form of a search result is created.) (Column 3, Lines 32-38) associated with the aspect and generated responsive, at least in part, to searching an article index using the user-context dependant search query (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM search engine."* The preceding text excerpt along with the above

disclosure clearly indicates that generating the insert (e.g. search result) associated with the aspect comprises searching an article/file index using the previously generated user-context dependant search query.) (Column 3, Lines 32-38).

Tripp fails to disclose causing the insert to be output in association with the aspect and the user context-dependent search query is based, at least in part, on a user action history comprising a plurality of user actions were performed on a plurality of articles.

Mathur discloses causing the insert to be output in association with the aspect (i.e. " *Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user.* " The preceding text excerpt clearly indicates that the insert (e.g. search result) is displayed in relation to the aspect of the article which it pertains to (e.g. the keywords used to form the implicit query).) (Page 1) and the user context-dependent search query is based, at least in part, on a user action history comprising a plurality of user actions associated with a plurality of articles (i.e. " *Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being*

browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user. " The preceding text excerpt clearly indicates that the user context-dependant search query will be based on a user action history based on user interactions with a plurality of browsed documents.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be output in association with the aspect and causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

Tripp and Mathur fail to disclose that the user action history includes a plurality of dates upon which the user actions were performed.

Brandli discloses that the user action history includes a plurality of dates upon which the user actions were performed (i.e. *"Consider, for example, document 321 and document 323, which both contain the term "A." Node 307 in the directory structure 304 contains an entry for the indexing term "A." This entry points to leaf structure 309, which contains references to two documents labeled "1" and "3." In the particular implementation shown, the leaf structures 309-312 point to a centralized list of documents for the entire content-index (object list 303) to avoid storing large or*

redundant amounts of information in the leaf structures themselves. Thus, the references to a document "1" and a document "3" in the leaf structure 309 indicate which documents in the object list 303 contain the indexing term. Specifically, leaf structure 309 indicates that the document referred to by the first entry 315 in object list 303 contains indexing term "A" and that the document referred to by the third entry 317 in object list 303 also contains the indexing term "A." The object list 303 also contains additional information regarding each object (document) that is indexed by the inverted list 302. As shown, object list 303 contains in each entry the name of the object, the location of the object, and a timestamp indicating the last time the object was updated. By examining the referred to entries in object list 303, the names and locations of the documents containing the indexing term "A" can be retrieved. Thus, the first entry 315 refers to the document "doc1.txt" 321 and the third entry 317 refers to the document "doc5.xls," both of which contain the term "A." The preceding text excerpt clearly indicates that the user action history may include timestamps representing when user actions were performed on the plurality of documents.) (Figure 3; Column 6, Lines 49-67; Column 7, Lines 1-8).

It would have been obvious to one skilled in the art at the time of Applicants invention to modify the teachings of Tripp and Mathur with the teachings of Brandli to include that the user action history includes a plurality of dates upon which the user actions were performed with the motivation of generating accurate search results using a content-index (Brandli, Abstract).

As per Claims 3 and 49, Tripp discloses the article index comprises an index of articles available on the World Wide Web (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that file index may include files/article available on the world wide web.) (Column 3, Lines 32-38).

As per Claims 4 and 50, Tripp discloses the article index comprises a local article index (i.e. *"Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that the article/file index may be an index of local articles/files.) (Column 3, Lines 32-38).

As per Claims 5 and 51, Tripp discloses the local article index comprises a messaging index (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article index may include email messages (e.g. a messaging index.) (Column 3, Lines 49-53).

As per Claims 8 and 54, Tripp fails to disclose the search result comprises at least one of an article identifier, a thumbnail, a text snippet, a Uniform Resource Locator, and a path

Mathur discloses the search result comprises at least one of an article identifier, a thumbnail, a text snippet, a Uniform Resource Locator, and a path (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of*

interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the search result may comprise a text snippet, URL, or path (e.g. link.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 11 and 57, Tripp Fails to disclose causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article.

Mathur discloses causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified*

by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the search result appears in a browser window separate from the article.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a window separate from the article with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claim 16, Tripp discloses the aspect comprises a hyperlink (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a hyperlink in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 17, Tripp discloses the aspect comprises a title (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or*

desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a title of/in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 18, Tripp discloses the aspect comprises an image (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, an image in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 19, Tripp discloses the aspect comprises a menu item (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index.*

The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine." The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, a menu item in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 20, Tripp discloses the aspect comprises an input field (i.e. *"At present, a typical user will use the "Find" utility within Windows to search for information on his personal computer or desktop, and a browser to search the internet. As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information, and then a separate browser must be used to perform Internet searches. The AltaVista.RTM. program is named AltaVista.RTM. Discovery, and generates a local index of files on a user's personal computer much like the central index. The program then provides integrated searching of the local index along with conventional Internet searches using the central index of the AltaVista.RTM. search engine."* The preceding text excerpt clearly indicates that, because the user can search for any aspect of a document/file/article they wish, an input field in a document may comprise the identified aspect.) (Column 3, Lines 21-38).

As per Claim 21, Tripp discloses the article comprises a web page (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise a HTML document/web page/Netscape file.) (Column 3, Lines 49-53).

As per Claim 22, Tripp discloses the article comprises a text document (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages*

such as Eudora, Netscape, text and PDF files, and various mail and document formats." The preceding text excerpt clearly indicates the article may comprise a text/Office document.) (Column 3, Lines 49-53).

As per Claims 23, Tripp discloses the article comprises an email message (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise an email message/Eudora file.) (Column 3, Lines 49-53).

As per Claims 24, Tripp discloses the article comprises an instant messenger message (i.e. *"The indexer handles different data types including Office'97 documents, various types of e-mail messages such as Eudora, Netscape, text and PDF files, and various mail and document formats."* The preceding text excerpt clearly indicates the article may comprise an instant messenger message (e.g. the instant messenger message could be in the form of a chat log (e.g. text document) or in the form of an email message.) (Column 3, Lines 49-53).

As per Claims 73 and 83, Tripp fails to disclose the user-context-dependent search query is further based on a client application a user is executing.

Mathur discloses the user-context-dependent search query is further based on a client application a user is executing (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the*

documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the context dependent search query is implicitly based on a client application the user is executing (e.g. the web browser used to view the page). (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include the user-context-dependent search query is further based on a client application a user is executing with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 74 and 84, Tripp fails to disclose the user-context-dependent search query is further based on a file upon which a user is performing an operation.

Mathur discloses the user-context-dependent search query is further based on a file upon which a user is performing an operation.

(i.e. "Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs

corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user.“ The preceding text excerpt clearly indicates that the context dependent search query is based on the web page (e.g. html file) which the user is browsing (e.g. has performed the action of opening.) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include the user-context-dependent search query is further based on a file upon which a user is performing an operation with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 75-77 and 85-87, the limitations of an action of the plurality of user actions is opening a file, an action of the plurality of user actions is printing a file, and an action of the plurality of user actions is sending an email message are considered to be non-functional descriptive material and are given no patentable weight as the nature of the user action has no effect on how the implicit search query is built, only it's subject matter.

From the MPEP:

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV. B.1(b). Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (combining printed instructions and an old product into a kit will not render the claimed invention nonobvious even if the instructions detail a new use for the product).< Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: - a computer-

readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

3. Claims 9-10 and 55-56 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view Mathur further in view of Brandli and further in view of Musgrove (U.S. Pre-Grant Publication Number 2005/0065909 and referred to hereinafter as Musgrove).

As per Claims 9 and 55, the Tripp-Mathur-Brandli invention as described above in relation to Claim 1 fails to disclose causing the insert to be output in association with the aspect comprises placing at least part of the insert into the article.

Musgrove discloses causing the insert to be output in association with the aspect comprises placing at least part of the insert into the article (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the insert (e.g. query result) may be inserted into the article as a link or advertisement.) (Page 9, Paragraph 62).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Musgrove to include causing the insert to be output in association with the aspect comprises placing at least part of the insert into the article with the motivation of associating inserts (e.g. search query results) with articles (e.g. documents) based on the context of the document (Musgrove, Abstract).

As per Claims 10 and 56, the Tripp-Mathur-Brandli invention as described above in relation to Claim 1 fails to disclose causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a transient display proximate to the aspect.

Musgrove discloses causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a transient display proximate to the aspect (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the insert (e.g. query result) may be displayed in the article as an advertisement proximate to the aspect. Note that it is common for advertisements to be cycled/reloaded on web pages, qualifying an advertisement as transient.) (Page 9, Paragraph 62).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Musgrove to include causing the insert to be output in association with the aspect comprises causing the display of at least part of the insert in a transient display proximate to the aspect with the motivation of associating inserts (e.g. search query results) with articles (e.g. documents) based on the context of the document (Musgrove, Abstract).

4. Claims 12-15 and 58-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Tripp in view of Mathur further in view of Brandli, as above, and in further view of Phelps ("All you can seek", Special Services, July 1999, Vol.7, Iss. 7, accessed on the web on

10/16/2006 at

<http://www.smartcomputing.com/editorial/article.asp?article=articles/archive/g0707/26g07/26g07.asp>..

As per Claims 12 and 58, Tripp-Mathur-Brandli fails to disclose at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference.

Mathur discloses at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that generating the insert (e.g. producing the search result) is based on user preferences in the form of search preferences.) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phleps to include at least one of identifying the aspect, generating the insert, and causing the insert to be output in association with the aspect is based, at least in part, on a user preference with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 13 and 59, Tripp-Mathur-Brandli fails to disclose receiving the user preference.

Phelps discloses receiving the user preference (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that the user may input the preferences (e.g. the preferences will be received).) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phelps to include receiving the user preference with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 14 and 60, Tripp-Mathur-Brandli fails to disclose determining the user preference based, at least in part, on a user action history comprising a plurality of user actions.

Phelps discloses determining the user preference based, at least in part, on a user action history comprising a plurality of user actions (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that the user preferences are based on a user action history comprising a plurality of user actions (e.g. the user setting the preferences).) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phelps to include determining the user preference based, at least in part, on a user action history comprising a plurality of user

actions with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

As per Claims 15 and 61, Tripp-Mathur-Brandli fails to disclose determining the user preference based, at least in part, on a system analysis.

Phelps discloses determining the user preference based, at least in part, on a system analysis (i.e. *"Discovery is a fully customizable program, so take some time to look through all of the different options. Once the program is fine-tuned to fit your needs, its powerful search features can save you all the time and clicks you would use to rake over your drives for some lost file. That's the kind of bargain we like the best."* The preceding text excerpt clearly indicates that after the user preferences have been set, the preferences will be determined for searching purposes by scanning the system to identify which user preferences the user has selected.) (Page 5, Paragraph 8, Page 6, Paragraph 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp-Mathur-Brandli with the teachings of Phelps to include determining the user preference based, at least in part, on a system analysis with the motivation that both Tripp and Phelps are describing the functionalities of the same product.

5. Claims 25 and 78-82 rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrove et al. in view of Mathur and further in view of Brandli.

As per Claim 25, Musgrove discloses a method comprising: identifying an aspect associated with an article (i.e. *"...determining word scores of the words in the document based on the frequency of the words in the document, adjusting the word scores of the words by predetermined*

weightings corresponding to the use of each word in the document, constructing a keyword query search string using words having the highest word scores..." The preceding text excerpt clearly indicates that an aspect associated with an article (e.g. keywords in a web page) are identified.) (Page 2, Paragraph 16); automatically searching a local article index with a user context-dependent search query for a search result associated with the aspect (i.e. "...searching the product records of the products database to identify products satisfying the keyword query search string, assigning product scores to the identified products based on matches to the keyword query search string, parsing the product records to identify word matches in each of the product records and the document, updating the product score by processing the adjusted word scores corresponding to the matched word with the product score of the product for which word matched, and selecting products from the identified products that have the highest updated product scores..." The preceding text excerpt clearly indicates that a local article index (e.g. product database) is automatically searched with the a query associated with the aspect. Note that as the user requested the search be done (paragraph 26), the query is user context-dependant.) (Page 2, Paragraph 16); automatically generating an insert comprising the search result (i.e. "...searching the product records of the products database to identify products satisfying the keyword query search string, assigning product scores to the identified products based on matches to the keyword query search string, parsing the product records to identify word matches in each of the product records and the document, updating the product score by processing the adjusted word scores corresponding to the matched word with the product score of the product for which word matched, and selecting products from the identified products that have the highest updated product scores..." The preceding text excerpt clearly indicates that a search result (e.g. insert) is automatically generated.) (Page 2, Paragraph 16); placing the insert into the article such that the insert will be displayed near the aspect when the article is displayed (i.e. "The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider." The preceding text

excerpt clearly indicates that the insert (e.g. query result) may be inserted into the article as a link or advertisement.) (Page 9, Paragraph 62); and causing the article to be displayed (i.e. *"The re-sorted list of products is provided to the display module 28 that sends the results to the client 40 for display as advertisements or links, or in other format as being products that the user may want to consider."* The preceding text excerpt clearly indicates that the article (e.g. web page) may be displayed.) (Page 9, Paragraph 62).

Musgrove fails to disclose the user context dependent search query is based, at least in part, on a user action history comprising a plurality of user actions performed on a plurality of articles.

Mathur discloses the user context dependent search query is based, at least in part, on a user action history comprising a plurality of user actions performed on a plurality of articles (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the user context dependent search query (e.g. implicit query) is based on a user action history comprising a plurality of user action performed on a plurality of document (e.g. the history of user interaction within searched documents.) (Page 1).

It would have been obvious to one skilled in the art at the time of Applicants invention to modify the teachings of Musgrove with the teachings of Mathur to include the user context dependent search query is based, at least in part, on a user action history comprising a plurality of user actions performed on a plurality of articles with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

Musgrove and Mathur fail to disclose that the user action history includes a plurality of dates upon which the user actions were performed.

Brandli discloses that the user action history includes a plurality of dates upon which the user actions were performed (i.e. *"Consider, for example, document 321 and document 323, which both contain the term "A." Node 307 in the directory structure 304 contains an entry for the indexing term "A." This entry points to leaf structure 309, which contains references to two documents labeled "1" and "3." In the particular implementation shown, the leaf structures 309-312 point to a centralized list of documents for the entire content-index (object list 303) to avoid storing large or redundant amounts of information in the leaf structures themselves. Thus, the references to a document "1" and a document "3" in the leaf structure 309 indicate which documents in the object list 303 contain the indexing term. Specifically, leaf structure 309 indicates that the document referred to by the first entry 315 in object list 303 contains indexing term "A" and that the document referred to by the third entry 317 in object list 303 also contains the indexing term "A." The object list 303 also contains additional information regarding each object (document) that is indexed by the inverted list 302. As shown, object list 303 contains in each entry the name of the object, the location of the object, and a timestamp indicating the last time the object was updated. By examining the referred to entries in object list 303, the names and locations of the documents containing the indexing term "A" can be retrieved. Thus, the first entry 315 refers to the document "doc1.txt" 321 and the third entry 317 refers to the document "doc5.x1s," both of which contain the term "A."*) The preceding text excerpt clearly indicates that the user action

history may include timestamps representing when user actions were performed on the plurality of documents.) (Figure 3; Column 6, Lines 49-67; Column 7, Lines 1-8).

It would have been obvious to one skilled in the art at the time of Applicants invention to modify the teachings of Musgrove and Mathur with the teachings of Brandli to include that the user action history includes a plurality of dates upon which the user actions were performed with the motivation of generating accurate search results using a content-index (Brandli, Abstract).

As per Claims 78, Musgrove fails to disclose the user-context-dependent search query is further based on a client application a user is executing.

Mathur discloses the user-context-dependent search query is further based on a client application a user is executing (i.e. *"Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user."* The preceding text excerpt clearly indicates that the context dependent search query is implicitly based on a client application the user is executing (e.g. the web browser used to view the page).) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include the user-context-dependent search query is further based on a client application a user is executing with the motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 79, Musgrove fails to disclose the user-context-dependent search query is further based on a file upon which a user is performing an operation.

Mathur discloses the user-context-dependent search query is further based on a file upon which a user is performing an operation.

(i.e. "Some search engines also perform searches implicitly without receiving specific user input based on the contents of documents (e.g., web pages) viewed by the user. These search engines use the contents of the document being browsed/viewed by the user as a search query which is communicated from the user computer to the search engine server. Based on the contents of the document being viewed by the user and based upon index information used by the search engine, the search engine identifies documents of interest to the user. Information related to the documents identified by the search engine is then communicated to the user system. The information may then be presented to the user via a pop-up screen which appears on an output device of the user's computer system. For example, in a Web environment, a window may appear on the user's display device listing URLs corresponding to documents identified by the search engine to be of interest to the user based on the contents of the documents presently viewed by the user." The preceding text excerpt clearly indicates that the context dependent search query is based on the web page (e.g. html file) which the user is browsing (e.g. has performed the action of opening).) (Page 1).

It would have been obvious to one skilled in the art to modify the teachings of Tripp with the teachings of Mathur to include the user-context-dependent search query is further based on a file upon which a user is performing an operation with the

Art Unit: 2165

motivation of identifying and accessing documents of interest to the user (Mathur, Abstract).

As per Claims 80-82, the limitations of an action of the plurality of user actions is opening a file, an action of the plurality of user actions is printing a file, and an action of the plurality of user actions is sending an email message are considered to be non-functional descriptive material and are given no patentable weight as the nature of the user action has no effect on how the implicit search query is built, only it's subject matter.

From the MPEP:

If the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine, Office personnel must determine whether the descriptive material is functional descriptive material or nonfunctional descriptive material, as described supra in paragraphs IV.B.1(a) and IV. B.1(b). Functional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art. In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (combining printed instructions and an old product into a kit will not render the claimed invention nonobvious even if the instructions detail a new use for the product).< Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are: - a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium, - a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or - a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention. Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Hicks whose telephone number is (571) 272-2670. The examiner can normally be reached on Monday - Friday 8:30a - 5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Michael J Hicks
Art Unit 2165
Phone: (571) 272-2670
Fax: (571) 273-2670

/Christian P. Chace/

Supervisory Patent Examiner, Art Unit 2165